

ELIGIBILITY REQUIREMENTS FOR NASA's INVENTION OF THE YEAR AWARDS

I. BACKGROUND

- NASA develops and funds the development of many valuable innovations. In keeping with NASA's Mission to transfer cutting edge technology to U.S. industry to enhance U.S. industrial competitiveness in the international marketplace, it is Office of the General Counsel policy that, generally, NASA should file patent applications only on those innovations having commercial potential. Many of NASA's patented inventions have realized their commercial potential through licensing to U.S. industry. Others, while not resulting in licensing activity, nonetheless contribute significantly to specific NASA programs by, for example, improving mission safety and/or reliability, or saving considerable amounts of time and/or money. The General Counsel believes that both types of inventions provide beneficial contributions to NASA's mission and both should be considered for awards. Thus, in 1993, the General Counsel modified the existing Invention of the Year Award contest. As a result, two distinct awards may now be presented: (1) the NASA **Commercial Invention of the Year Award**; and (2) the NASA **Government Invention of the Year Award**.
- There is no requirement that both awards be presented each year. For example, while we emphasize commercial potential in our patent program, it is possible that no invention will satisfy NASA's Commercial Invention of the Year Award eligibility requirements. In that case, only a NASA Government Invention of the Year will be selected. On the other hand, a single nomination can win both awards.
- There is no need to identify a nomination as applying to one particular contest. Nominations may be submitted for each contest; however, all nominations will be considered for both Awards.
- The winner of NASA's Commercial Invention of the Year Award, if any, will become NASA's nominee for the Intellectual Property Owners Educational Foundation (IPO Educational Foundation) National Inventor of the Year Award.

II. GENERAL ELIGIBILITY REQUIREMENTS - The following requirements apply to both the NASA Commercial Invention of the Year Award and the NASA Government Invention of the Year Award. To be eligible for consideration for either award, the nominated invention must satisfy all of the following requirements.

- **The invention must have at least one NASA employee as an inventor.** Inventions made jointly with non-NASA employees are also eligible. Nominations must include the names of all inventors including NASA and non-NASA employees.

- **A United States Patent covering the invention must have issued.** The patent need not have issued during the award year, but may have issued in a previous year. Only inventors listed on the issued patent(s) will be considered for the award.
- **The invention as patented must have been actually reduced to practice.** That is, a physical embodiment of the patented invention must have been produced and tested so as to indicate that the invention works as intended in practical applications. The first actual reduction to practice need not have occurred during this award year but may have occurred in a previous year.
- **NASA must have an ownership interest in the invention.** Inventions developed by NASA civil servant employees, or under NASA contracts, grants or cooperative agreements, may be assigned to the United States Government as represented by the Administrator of NASA. Although rights flow to the entire Government, for these award requirements, such an assignment is considered an assignment to NASA.

For example:

- ◆ Generally, before NASA files patents on inventions made solely by NASA civil servant employees, the NASA employee(s) must assign his/her interest to NASA. Thus, a patented invention having only NASA employee inventors is eligible.
- ◆ An invention made jointly by a NASA employee, who assigned his/her interest to NASA, and an employee of another Government agency, who assigned his/her interest to that agency, is eligible.
- ◆ An invention made jointly by a NASA employee, who assigned his/her interest to NASA, and a non-Government employee, who assigned his/her interest to his/her company, so that a joint ownership situation exists, is also eligible.

III. **SPECIFIC ELIGIBILITY REQUIREMENTS** - These requirements, which are specific to a particular award, are in addition to the general requirements. To be eligible for consideration for a specific award, the nominated invention must satisfy all of the specific eligibility requirements as well as all of the general eligibility requirements.

Specific NASA Commercial Invention of the Year Eligibility Requirements

- **The invention must have become first commercially available during the four year period ending with the calendar year of the Award, i.e., the Award year and the three preceding years.** For the 2008 contest, the applicable four-year period runs from 2005 to 2008.
 - ◆ To become commercially available, the invention must be licensed to a licensee that has produced and sold the licensed invention. Merely announcing a product or offering it for sale does not make it commercially available.

- ◆ Thus, to satisfy this requirement first, delivery of a licensed invention from a licensee to a purchaser must have occurred during the applicable four-year time period.
- ◆ There can be, and often is, a substantial hiatus between the patent date and the first commercial availability of the invention. Thus, it is important to state the facts regarding commercial availability in the nomination package.
- **NASA must have received royalties based on the licensed invention.** An indication that NASA has received royalties based on the licensed invention must be provided. However, specific dollar amounts need not be provided.

Specific NASA Government Invention of the Year Eligibility Requirements

- **The invention must be significant to a NASA mission.** That is, the invention must have provided a significant and identifiable benefit to a NASA project or program. The benefit must have occurred for the first time during the four-year period ending with the calendar year of the Award. For the 2008 contest, the applicable four-year period runs from 2005 to 2008.
- Significant and identifiable benefits include, but are not limited to, the following.
 - ◆ The invention is in actual use in a specific, identified NASA project or program. An invention being tested for possible use in a NASA project or program does not satisfy this requirement.
 - ◆ The invention results in monetary and/or time savings to a NASA project or program.
 - ◆ The invention increases mission safety.
 - ◆ The invention results in enhanced operations or performance, e.g., increased reliability and/or efficiency.
 - ◆ Inventions that provide a positive public relations benefit, but no other identifiable benefit, do not satisfy this requirement.
 - ◆ Royalties do not provide a benefit to a specific program alone, but provide a benefit to NASA as a whole, and thus are considered under the Commercial Invention of the Year Award requirements.

Repeat Nominations Permitted

- An invention may be nominated a second time in a succeeding year when there has been a substantial increase in the benefit to NASA or in the commercial availability. Previous nominees under the old rules (prior to 1993) may also be nominated a second time. For example, under the old rules, an invention could be nominated if the patent issued during the Award year. Our new rules permit the same invention to be nominated again if the invention first demonstrated a benefit to NASA or first became commercially available during the applicable four-year period.
- Previous winners are ineligible.

IV. CENTER SCREENING

- It is recommended that a technical, peer-review-council review all nominations and ensure all eligibility requirements are met and documented in the nomination package.

V. NOMINATION PROCEDURES

- Nominations must be timely submitted to Headquarters electronically, preferably via the MINX server Inbox if at all possible.
- Each Center's nomination(s) shall be placed in a folder named by the NTR number convention, i.e. "ABC-12345-IOY".
- All files in the folder shall be named similarly, with additional identification in the filename, i.e. "ABC-12345-IOY-form1329" or "ABC-12345-IOY-patent"
- Faxes of the form 1329 Signature pages are acceptable if needed, but hard copies mailed to HQ are not required as duplication and distribution of hard copies to the Board members is not practical.
- Each nomination must include at a minimum:
 - ◆ A copy of the issued patent.
 - ◆ A photograph or drawing of the invention.
 - ◆ Form 1329, ICB Award Evaluation Questionnaire, (Form 1329A, Reevaluation Form, if the invention has been previously submitted to the Inventions and Contributions Board for award consideration) that addresses the following important topics:
 - A brief description of the invention's form and function.
 - A detailed explanation of the invention's first commercial availability - including the identity of licensee(s), type of license(s), (exclusive, partially exclusive, or non-exclusive).
 - Verification that sales of the invention(s) have occurred and royalties have been received (specific sales figures or royalty amounts may be provided but are not required). **Any proprietary information included should be clearly marked as such.**
 - Detailed descriptions of significant and identifiable benefit to a NASA project or program.
 - Detailed descriptions of the performance, utility, and value to NASA, the Nation, industry, and the general populace.
- A presenter or presenters, who may include an inventor of the nominated invention, is invited to give up to a 15-minute technical summary of the invention to the Invention of the Year selection panel. Videotapes are also acceptable if delivered in a timely fashion to the ICB staff at NASA HQ. Notification of intent to do so should be provided to the ICB staff at the time of the nomination submission.